

NEC01P072-TSe
Amendment dated 08/31/2004

09/872,522

01480072aa
Reply to office action mailed 06/08/2004

REMARKS

Claims 1-59 are currently pending in the application, with claims 23-32 and 34-59 having been provisionally withdrawn from consideration in response to a restriction requirement and election. Claims 1, 2, 3, and 9 have been amended for the Examiner's consideration. The foregoing separate sheets marked as "Listing of Claims" shows all the claims in the application, with an indication of the current status of each .

The Examiner has objected to drawing figures 2-6 because they include "reference signs" not mentioned in the description. The symbols objected to merely show interconnections in a complex flow chart. In principle, this complex flow chart could have been presented on a single oversized drawing sheet, with appropriate connecting lines between reference signs. However, in order to present this complex flow chart more conveniently and more clearly, within the constraints of 37 C.F.R. §1.84(f), the flow chart has been allocated over several drawing figures, and connection conventions well known to those skilled in the art have been used to show the interconnections. These well known connection conventions are implemented in symbols, and these are the symbols objected to by the Examiner. The symbols objected to are not "reference signs" but rather a conventional manner of expressing mere connecting lines between reference signs, where it is otherwise impractical or confusing to draw the complete lines. It will be observed that these symbols are entirely self-contained within the drawings and require no explanation in the specification to enable those skilled in the art to understand their significance as alternative expressions for showing how simple lines are connected. It is therefore submitted that the symbols objected to are not "reference signs" as described in 37 C.F.R. §1.84(p) at all. It should be noted that they are letters enclosed within circles, in accordance with the common convention known to those skilled in the art. If the Examiner is not convinced by this argument, and still prefers an amendment to the

NEC01P072-TSe
Amendment dated 08/31/2004

09/872,522

01480072aa
Reply to office action mailed 06/08/2004

specification, a proposed amendment is provided. No new matter is added by this proposed amendment, but the applicant believes the amendment is not necessary and requests that the Examiner reconsider his objection.

The Examiner has objected to certain informalities in claims 1 and 9. These are corrected by the present amendment.

The Examiner has rejected claims 9-22 under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. In particular, the Examiner indicates that in claim 9 “means for determining” in line 8, “means for performing ... the purchase procedure” in lines 10-11, and “means for notifying the user ... that the trial purchase procedure cannot be provided” in lines 12-13 are not found in the disclosure. These grounds for rejection are traversed. The necessary means are evident in the specification and drawings to one skilled in the art. For example, the “means for determining” in line 8 is described in the specification at page 12, lines 16-20, and in the flow chart described in Figures 2-6. A journeyman programmer would be able to implement the “means for determining” from the disclosure in the specification and flow chart. In accordance with the specification and drawings, the structure would be imbedded in software, portions of which are resident on the terminal 1-1 and other portions of which comprise the selling system 3.

It may be helpful to show in detail how the desired information comes to be stored in the customer information database 5. It will be observed that a user at a terminal is either a member or not a member. At the user’s earliest contact with the system, prior to considering membership, the user would not have been a member and will access a trial purchase page at S1 (on Figure 2), completing the information for a trial purchase at S16 after interaction via S5 with commodity information database 4. From there the user will move to S17 (on Figure 3), and because he is not yet a member the user is diverted to S28 (on Figure 4) and then through S29, S34, S35 (all on Figure 4) and then to S36 (on Figure 5) where storage of customer information in

NEC01P072-TSe
Amendment dated 08/31/2004

09/872,522

01480072aa
Reply to office action mailed 06/08/2004

the customer information database 5 is confirmed and the ID/password is issued, whereupon the user is returned to S30 (on Figure 4) for entry of the ID/password, which is checked at S32, whereupon the user is returned to S18 (on Figure 4). At this point, the structure implementing the segment of the flow chart beginning at S20 completes performance of the trial purchase procedure for the user, in accordance with the "means for performing" element of the invention. At S21 the customer information is displayed along with the contents of the trial purchase order. It is to be noted from Figure 1 that both the commodity information database and the customer information database are available to the selling system, and that one skilled in the art would understand that prior use of the system by the user would be stored and would be available to the selling system via the customer information database. When the contents of the trial purchase order is correct and not further to be changed the user goes to S23 and S24. As described at page 13, lines 19-26, since this is a trial purchase there will be no selection of a payment method because the commodities are free of charge. Thereafter, however, when this user enters the system again at S1, reaches a purchase determination at S16, and then reaches S18, the fact of the prior trial purchase is available via the customer information database 5, and the user will be diverted to S19. Implementation of this diversion within the trial purchase system (and in particular within selling system 3 as shown in Figure 3) coupled with display at S19 (within the terminal 1-1 as shown in Figure 3) constitutes the "means for notifying" structure in accordance with the invention.

Consequently, one skilled in the art would be able to prepare a software program constituting "means for determining" in line 8, based on the disclosure in the specification and drawings. Similarly, "means for performing ... the purchase procedure" in lines 10-11, and "means for notifying the user ... that the trial purchase procedure cannot be provided" in lines 12-13 are amply demonstrated to one skilled in the art. The Examiner asserts that the necessary structure is not enabled, but the applicant traverses that conclusion, since as demonstrated above the necessary

NEC01P072-TSe
Amendment dated 08/31/2004

09/872,522

01480072aa
Reply to office action mailed 06/08/2004

programming structure is evident from the specification and drawings to one skilled in the art. It is therefore submitted that the Examiner's §112, first paragraph, rejection is overcome and reconsideration is respectfully requested.

The Examiner has rejected claims 2, 3, 4, 6-8 and 10 under 35 U.S.C. §112, second paragraph, as being indefinite because the limitation "previously" in line 3 leaves in doubt when the storing occurs. It will be observed from the flow chart in Figures 2-6 that change of delivery destination information is provided as shown on Figure 6, beginning at S49. The user would reach this point from S41 if no prior destination information – from a prior purchase – was stored in the customer information database 5, and therefore the destination information was missing from the display at S21. However, as described at page 13, lines 3-9, the destination information may have been previously stored in the customer information database 5 because of a prior purchase. It is in this sense that the term "previously" is used. The claims have been amended to further clarify the applicant's intention. It is therefore submitted that the Examiner's §112, second paragraph, rejection is overcome.

The Examiner has rejected claims 1 and 2 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,571,216 to Garg et al. Claims 3 and 5-7 appear also to be rejected using Garg. Claims 9-22 and 33 are rejected as "inherently constructed" based on Garg. Garg discloses a methodology and system that allows a plurality of reward scheme owners to give differential rewards, through a plurality of reward distribution agents, to various users based on a user profile. The reward scheme owner may be a seller, a manufacturer, a sales promotion agent or even an intermediary. Similarly, the reward distribution agent may be an on-line or a physical retailer, a broker, a seller or an intermediary. Also the users may be consumers, businesses, brokers or other intermediaries. In one specific case, a reward scheme owner defines a plurality of reward schemes, including at least one differential reward scheme giving different rewards to different users. The reward scheme owner communicates these to a central reward scheme database server. The reward scheme

NEC01P072-TSe
Amendment dated 08/31/2004

09/872,522

01480072aa
Reply to office action mailed 06/08/2004

owners may or may not advertise these schemes. The user visits an online or a physical store. The store acting as a reward distribution agent dynamically profiles the user, queries the central reward scheme database server if the user profile meets the criterion for one or more rewards and offers the applicable rewards to the user. The store later receives reimbursement for the rewards offered to various users, from the reward scheme owners. This methodology and system may be used for offering targeted or differential discounts on different products and services, offering different promotional schemes on different combination of products, giving loyalty points, electronically distributing prizes, free samples, product warranties, tie-in promotions, cross selling, up selling, premiums, memberships, card discounts, organizing contests, sweepstakes, games and offering other similar rewards.

Garg discloses – as one of its strategies for responding to a user profile – the option of giving a free sample to the user. However, in the present invention the system makes a determination whether the system has already provided the user with a trial purchase and conditions further provision of a trial purchase upon that determination. Further, the definition of “free sample” in Garg is responsive to the system’s assessment of a “user profile”. By contrast, a “trial purchase” in the present invention is responsive to purchasing selections made by the user. There is no indication in Garg that a user purchasing selection results in a “free sample.” Garg does mention the concept of “boni” wherein merchants are willing to offer lower prices in the early part of the day (col. 4, lines 56-62), but this concept requires that money be earned, which is inconsistent with a “free sample.” Garg also discloses reward schemes such as “buy one, get one free” where the user is required to purchase “m out of n” of specified products and services. Again, in contrast to the present invention, these schemes involving user purchasing selection necessarily require the user to part with his money. Thus, Garg fails to disclose a “trial purchase” as claimed in the present invention. And while Garg discloses retention in the user profile of past rewards offered, there is no suggestion in Garg of conditioning a further “trial

NEC01P072-TSe
Amendment dated 08/31/2004

09/872,522

01480072aa
Reply to office action mailed 06/08/2004

purchase” on lack of past participation of the user in a “trial purchase.” Furthermore, the use of the logs of past rewards offered is discussed in terms of proof of a valid user transaction, in order to justify reimbursement from the reward scheme owners (col. 7, lines 18-22). This teaches away from any use of such logs in the manner of the present invention. At another point in the disclosure, Garg indicates that the value of a reward may be a function of the number of times a user visits a product page (col. 8, lines 10-12), but this is different from conditioning further trial purchases on lack of past participation in a trial purchase. Garg also indicates that if a customer goes to a reward distribution agent to collect a reward earned (e.g., the reward may be to purchase an item at a discount), the agent then checks a database to confirm the details of the discount and, if it is confirmed that the user is due the reward, the agent provides the discount, which the user may or may not accept (col. 12, lines 24-32). However, qualifying or not qualifying for a discount on an item not selected by the user is well known in the art and has nothing to do with the “trial purchase” procedure of the present invention.

It should be emphasized that the “trial purchase” according to the present invention is defined, in the preamble, as “for allowing users ... to experience a purchase procedure ... provided from ... commodity providing means.” In view of this explicit statement in the claims, it cannot be said that “trial purchase” reads on “free sample” absent an indication – an indication not present in Garg – that the transaction flows from the purchase procedure experience, i.e. that the user obtains a “free sample” of the very product or service selected by the user in the course of experiencing the purchase procedure offered by the system.

The present invention is intended to overcome initial hesitance of a customer to use a web page for making purchases, by using the web page to distribute selected products for free (see page 13, line 26) or for a reduced charge and for limited quantities (see page 9, lines 1-4). The problem being addressed by the present invention is the contrast between the in-store purchase experience familiar to the user

NEC01P072-TSe
Amendment dated 08/31/2004

09/872,522

01480072aa
Reply to office action mailed 06/08/2004

and the online experience (page 3, lines 10-13). The trial purchase commodity may be provided for pickup at the designated destination (page 4, line 17). The invention provides mechanisms to overcome first time customer hesitancy to engage in online purchase for reasons such as fear of paying for a commodity and not receiving it (page 3, lines 17-18) or not knowing whether or how or at what cost a commodity can be changed (page 3, lines 20-24). Since the invention is directed to new customers, provision is made in the invention for limiting the trial purchase opportunity to those who have not already performed a trial purchase (see step S18 in Figure 3), although a merchant may provide the trial purchase service more than once to the same customer (page 13, lines 1-2).

For the foregoing reasons it is evident that the present invention, as claimed in claims 1 and 9, is not anticipated by Garg and are believed to be in allowable form. Since the remaining claims depend from claims 1 and 9, the §102 rejection is also overcome as to the remaining claims.

The Examiner has rejected claims 4 and 8 under 35 U.S.C. §103(a) as being unpatentable over Garg in view of the StartSampling.Com publication. The Examiner has acknowledged that the Start Sampling web page fails to limit further use of the purchase procedure by users who have had prior experience with the purchase procedure. The Examiner implicitly argues that Garg supplies this omission, but as the foregoing discussion in connection with the §102 rejection makes clear, the Garg reference fails to provide the "trial purchase" disclosure. Consequently, it is submitted that claims 4 and 8 overcome the §103 rejection.

In view of the foregoing, it is requested that the application be reconsidered, that claims 1-22 and 33 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 703-787-9400 (fax: 703-787-7557; email: clyde@wcc-ip.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

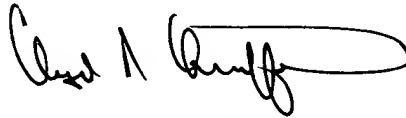
NEC01P072-TSe
Amendment dated 08/31/2004

09/872,522

01480072aa
Reply to office action mailed 06/08/2004

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Clyde R. Christofferson", with a large, sweeping loop at the end.

Clyde R Christofferson
Reg. No. 34,138

Whitham, Curtis & Christofferson, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190
703-787-9400
703-787-7557 (fax)

Customer No. 30743